IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Nobuo KIMURA *et al.*	Art Unit: 1754
Serial No. 09/530,196	Examiner: Edward M. Johnson
Filed: August 22, 2000	Atty. Docket No. 63365-224250 [formerly 31981-160441]
For: METALLIC PLATE OR RESIN STRUCTURE HAVING PHOTOCATALYST SUPPORTING FILM LAMINATED THERETO	Customer No. 26694 PATENT TRADEMARK OFFICE

REQUEST: PRE-APPEAL CONFERENCE

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Sir:

This paper is filed concurrently with a Notice of Appeal. Applicants petition for a one month extension of time. [Fees are to be charged to Deposit Account 22-0261.] Reversal or withdrawal of the June 12, 2006 FINAL REJECTION of claims 18, 24-39 and 41 is respectfully solicited. Failure to make the second factual inquiry under Graham constitutes factual and legal error here.

The subject matter on appeal is set forth in independent Claim 18 and in e.g. Claim 41:. Claim 18 is a method claim comprising the steps (a), (b) and (c), wherein (c) is

> "(c) heat-pressing the photocatalyst-supporting film onto a surface of a metallic plate or a resin substrate at a temperature range from 100 to 200°C to form an integral laminate."

Claim 41 recites that the pressure of the laminating step ranges from 3 to 160 kg/cm^2.

Therefore, the photocatalyst-supporting film is heated [under pressure] after forming the photo catalyst layer. Specifically, after the photo catalyst layer of the photocatalyst-supporting film is formed by drying(heating) the coating solution, the photocatalyst-supporting film (photo catalyst layer /adhesive layer/base film) is directly laminated, by heat-pressing at a temperature range from 100 to 200°C, onto a metal plate or a resin substrate to form an integral laminate.

All elected claims are rejected, under 35 U.S.C. 103, over Kimura JP WO97/00314 [Statements herein are based on the description of U.S. 6228480, the U.S. counterpart of WO97/00314, hereinafter "Kimura"].

The grounds of rejection is based on speculation: Kimura does not describe the temperature of Claim 18 and does not recite a pressure lamination or the specific pressure range of Claim 41.

Generally, the Kimura examples use dipping, spraying, printing, and bar coating to apply to a substrate an adhesive layer, followed by a coating --of the photocatalyst layer using the same technique as in forming the adhesive layer--.

The United States Patent and Trademark Office states, in Item 2 of the Final Office Action [page 2], that "Regarding Claim 18, Kimura '480 discloses a photocatalyst-carrying structure comprising a photocatalyst film laminated (see column 15, lines 44-46 and column 37, line 12-15 [excerpted below];" and the USPTO *concludes* "laminating involves heat and pressing)..." At column 15 lines 40-46, Kimura states:

> As a method to provide a sticker and ***a detachable film*** onto a photocatalyst-carrying film, a method to firstly coat a sticker in solution to the reverse side of the film by means of gravure printing and then dry and roll the coated film together with detachable polypropylene film while laminating it therewith is simple and may be preferably employed.[emphasis added]

Kimura Example 73 [column 37 lines 5-17]states,

> Next, to the surface of the photocatalyst-carrying structure comprising [sic] polyester film whereto a photocatalyst was not applied, a solution prepared by adding 5% by weight on the solid basis of a coating agent for blocking thermic rays... was applied by employing gravure printing method. The film applied with the sticker was winded while laminating the film with polyethylene film...at a process for drying and winding at the drying zone in the gravure printer, to thereby providing a sticking film.

Kimura describes the preparation of a tape provided with a detachable film via a sticker. The purpose of this is to make the tape handy and usable by simply peeling of the detachable film. Therefore, production of a detachable film which can be easily peeled, by rolling or winding disclosed in Kimura does not necessarily involve heating and pressing. Moreover, Kimura discloses that the produced films can be used for a sticking film for window glass for automobiles in Example 73, and thus it is obvious that the preparation of Kimura is a photochemical/adhesive layer/base film/ metallic base plate or resin base. That is, the preparation of Kimura is laminating by means of adhesion; and the preparation of the present invention is for laminating by means of heat-pressing.

Vis-à-vis claim 18, the USPTO found in the Office Action at page 3 that, Kimura fails to disclose the specific temperature of 60 [sic] to 200 °C [USPTO Paper of June 12, 2006, page 3].

Regarding the limitation of the temperature range of 60 to 200 °C, the USPTO states that "[I]t would have been obvious ... because Kimura '480 discloses the laminating 'at a process for drying and winding at the drying zone' (see Example 73) and drying the coated substrate at 150 °C or less as a method to carry an adhesive layer on the substrate (see column 6, lines 19 – 27)."

[USPTO, June 12, 2006, page 3].

However, the temperature of 100 to 200 °C in the amended Claim 18 is a temperature used when forming an integral laminate after drying the coated substrate, and not a temperature used when drying the coated substrate. Therefore, Kimura does not disclose heating of the photocatalyst-supporting film after forming the photo catalyst layer at the temperature of 100 to 200 °C to form an integral laminate.

Moreover, in the many findings made by the Examiner, the Examiner can not find the pressure range of Claim 41. [USPTO, June 12, 2006, page 4, third paragraph]. The only allegation is that any pressure range would have been obvious [USPTO, June 12, 2006, page 4].

Thus, there are two differences between Kimura and the appealed claims: temperature and pressure recitations. See Graham v. John Deere.

The USPTO [USPTO, December 16, 2005, page 5, third full paragraph] stated that:

> "one skilled in the art would interpret the term 'laminating' to inherently involve both heating and pressing in such as way as to not destroy the disclosed film or sticker, since that would destroy the disclosed invention of Kimura. And, in any case, at least some additional heat would be generated through at least friction by the winding and pressing as disclosed in Kimura".

The USPTO has presented no evidence to assert that laminating necessarily involves heating under pressure. However, as described above, the photocatalyst-supporting film of Kimura is not heated after forming the photo catalyst layer. In addition, even if additional heat is generated through friction by the winding disclosed in Kimura, the USPTO has presented no art to show that "additional heat" would cause a temperature of 100°C which is the lowest temperature in the amended claim 18.

The only evidence on the issue is presented as an attachment to applicants' April 17, 2006 Amendment. Pyrene film P-2161 used in Example 73 of Kimura '480 shrinks under heating for 5 min at 120°C, as shown in the bottom of the Table "General quality of Pyrene film-OT (P-2161) manufactured by Toyobo Co., Ltd" of the attached Exhibit. Therefore, a person skilled in the art would easily recognize that the temperature "at a process for drying and winding at the drying zone" in Example 73 of Kimura '480 is less than 100°C in order not to shrink the laminated Pyrene film P-2161.

In applicants' view, Kimura leads way from the claims of the instant case. After the photo catalyst layer of the photocatalyst-supporting film is formed, the photo catalyst layer of the photocatalyst-supporting film is formed by drying (heating) the coating solution, the photocatalyst-supporting film (i.e., photo catalyst layer /adhesive layer/support/adhesive (i.e., sticker)/detachable PP film) is obtained. When used, the PP films is peeled off and the rest is attached to a metal place. Therefore, the photocatalyst-supporting film is not heated at a temperature of 100 to 200 °C after forming the photocatalyst layer.

Reconsideration and an early allowance are respectfully solicited.

Respectfully submitted,

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